



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,239	02/19/2004	Jean-Louis Guyot	C-CPI-0114	1428

7590 04/17/2006

Leon D. Rosen  
FREILICH, HORNBAKER & ROSEN  
Suite 1220  
10960 Wilshire Blvd.  
Los Angeles, CA 90024

EXAMINER

VAN, LUAN V

ART UNIT	PAPER NUMBER
----------	--------------

1753

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/783,239

Applicant(s)

GUYOT, JEAN-LOUIS

Examiner

Luan V. Van

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/28/04.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, drawn to a method and apparatus, classified in class 205, subclass 135.

II. Claims 9-11, drawn to a product, classified in class 428, subclass 603.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as sputter deposition or chemical vapor deposition.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper, restriction for examination purposes as indicated is proper.

During a telephone conversation with the Applicant's representative, Mr. Leon Rosen on April 12, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8.

Affirmation of this election must be made by applicant in replying to this Office action. Invention of Group II, claims 9-11, is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sewell et al.

Regarding claims 1 and 6, Sewell et al. teach an apparatus and a method for depositing an electrically conductive layer of precious metal (column 1 lines 11-16) on a face of a metal substrate 1 (figure 1) by maintaining a mask 15, 16 closely over the substrate face while the face and mask are immersed in an electrolyte and the precious metal is electrodeposited through the electrolyte onto the substrate face, comprising: maintaining a screen 7 closely between said mask and said substrate face, said screen having a regular pattern of through holes (column 5 lines 25-29), and including flowing the electrolyte into said through hole and against the substrate face (column 8 lines 29-

Art Unit: 1753

50), and electrodepositing the precious metal through the electrolyte lying in said holes onto the substrate face. The mask 7 of Sewell et al. is broadly interpreted to read on the screen of the instant claim, since it contains a regular pattern of through holes.

Regarding claim 5, Sewell et al. teach the mask is of elastomeric material (column 3 lines 65-68), and including compressing said screen between said mask and said substrate face, and maintaining locations on said screen that lie in openings of said mask against said substrate face (column 9 lines 29-34).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sewell et al. in view of Topelian.

Art Unit: 1753

Sewell et al. teach the method and apparatus as described above. Sewell et al. differ from the instant claims in that the reference teach a screen but does not explicitly disclose the screen is formed of multiple wires that have a rounded periphery (claim 2) nor the screen is woven from of threads of rounded cross-section (claims 4 and 7-8).

It is conventionally known in the art to use a woven screen in an electroplating process. For example, Topelian teaches an electroplating process for electroplating articles of irregular shape or articles having multi-planar areas using a deformable woven wire mesh fabric or screen (column 1 lines 70 -- column 2 lines 16).

Addressing claims 2, 4 and 7-8, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the method and apparatus of Sewell et al. by using the woven wire mesh of Topelian, because it would allow the metal deposited to conform to the shape of the substrate. With respect to claims 4 and 8, changing the size of the openings would have been an obvious modification within the ability of one having ordinary skill in the art, since the "mere scaling up of the prior art process capable of being scaled up... was not established patentability into claim to an old process so scaled" (MPEP 2144.04).

Regarding claim 3, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the thickness of the deposited coating through routine experimentation to suit the desired intended application.

### ***Conclusion***


Art Unit: 1753

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan V. Van whose telephone number is 571-272-8521. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LVV  
4/13/06

  
**ALAN DIAMOND**  
**PRIMARY EXAMINER**  
Tech Center 1700